

reviewed by the OPLA, the reissue application with the protest will be returned to the examiner. See MPEP § 1441.01 for a discussion as to protests under 37 CFR 1.291* in reissue applications.

1449.01 Concurrent Office Proceedings [R-9]

I. CONCURRENT REEXAMINATION PROCEEDINGS:

37 CFR 1.565(d) provides that if “a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will usually be made to merge the two proceedings or to suspend one of the two proceedings.” 37 CFR 1.991 provides that if “a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings.” If an examiner becomes aware that a reissue application and an *ex parte* or *inter partes* reexamination proceeding are both pending for the same patent, he or she should immediately inform his or her Technology Center (TC) or Central Reexamination Unit (CRU) Special Program Examiner (SPRE) or appropriate Quality Assurance Specialist (QAS).

Under 37 CFR 1.177, a patent owner may file more than one reissue application for the same patent. If an examiner becomes aware that multiple reissue applications are pending for the same patent, and an *ex parte* or *inter partes* reexamination proceeding is pending for the same patent, he or she should immediately inform his or her TC or CRU SPRE or appropriate TC QAS.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, and *an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent Legal Administration (OPLA) must be notified (by e-mail to the lead Senior Legal Advisor responsible for reexamination) that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two. See MPEP § 2285 for the procedure of notifying OPLA and general guidance, if a reissue application and an *ex parte* reexamination proceeding are both pending for the same patent, and an *inter partes* reexamination proceeding is not involved. See MPEP § 2686.03 where a reissue application and an *inter partes* reexamination proceeding are both pending for the same patent, regardless of whether an *ex parte* reexamination proceeding is also pending.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a). The patent owner should file in the reissue application, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.178(b) in order to alert the Office of the existence of the reexamination proceeding on the same patent. See MPEP § 1418. In addition, the patent owner should file in the reexamination proceeding, as early as possible, a Notification of Concurrent Proceedings pursuant to 37 CFR 1.565(a) or 1.985(a) (depending on whether the reexamination proceeding is an *ex parte* reexamination proceeding or an *inter partes* reexamination proceeding) to provide a notification to the Office in the reexamination proceeding of the existence of the two concurrent proceedings.

The patent owner may file a petition under 37 CFR 1.182 in a reissue application to merge the reissue application with the reexamination proceeding, or to stay one of the proceedings because of the other. This petition must be filed after the order to reexamine is issued (37 CFR 1.525, 37 CFR 1.931) in the reexamination proceeding. If the petition is filed before the reexamination order, it will not be considered, and will be returned to the patent owner by the TC or CRU Director, or expunged from the record, if entered into the Image File Wrapper (IFW) before discovery that the petition is an improper paper. If the petition is filed after the order to reexamine is issued, the petition and any other paper materials for the files for the reissue application and the reexamination proceeding will be forwarded to OPLA for decision. An e-mail will be sent to the lead Senior Legal Advisor of OPLA responsible for reexamination, providing notification that the petition is ready to be addressed.

Reexamination Certificate Is To Be Issued for a Patent, While a Reissue Application for the Patent Is Pending

The following provides guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination. This can occur, for example, where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent (for which reissue is requested) is permitted to proceed. It can also occur where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is too late to consider the question of stay or merger.

(A) The examiner will not act on the reissue application until the reexamination certificate issues and publishes.

(B) After the reexamination certificate issues and publishes--At the time that the reexamination certificate is issued and published, the Office will resume examination of the reissue application--(1) An Office action will be issued giving the patent owner (applicant) one month to submit an amendment of the reissue application claims, based upon the results of the concluded reexamination proceeding.

(2) The reissue application will then be examined. Any claim canceled by the reexamination certificate will be treated the same way as a claim lost in litigation, and stated in the next action to be deemed as canceled. The remaining claims will be examined. If the reissue application is subsequently allowed, the claims that were canceled by the reexamination certificate will be formally canceled in the reissue application by examiner's amendment (unless they have already been canceled by > the <applicant>). It is to be noted that the patent owner/applicant will have been advised in any decision suspending the copending reissue application to bring to the attention of the Office the issuance of the reexamination certificate, request a resumption of examination of the reissue application, and to include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding.

(3) Generally, further prosecution will be limited to claims narrower than those claims canceled *>as a result of< the reexamination certificate >(this includes any existing patent claims and any claims added in the reexamination proceeding)<. Any claims added thereafter, which are equal in scope to claims canceled *>as a result of< the reexamination certificate, or are broader than the scope of the claims canceled *>as a result of< the reexamination certificate, will generally be deemed as surrendered based on the patent owner's failure to prosecute claims of equal scope, and to present claims of broader scope in the reexamination proceeding. Such claims will be rejected under 35 U.S.C. 251. Further, a rejection of such claims based on estoppel will be made, citing to MPEP § 2308.03 as to treatment of claims lost in a proceeding before the Office, and noting that a reexamination is a "proceeding." An exception to the guidance stated in part (3) above: claims that are broader than the scope of the claims canceled *>as a result of< the reexamination certificate may be presented where:(a) The broader claims in the reissue application can be patentable, despite the fact that the claims in the reexamination are not; and

(b) The broader claims in the reissue application could not have been presented in the reexamination proceeding. Criterion (a) can occur if the broadened claims in the reissue application have an earlier effective date than those canceled by the reexamination

certificate (as where the claims in the reissue application are supported by a parent application, and the reexamination claims are not). Criterion (a) can also occur if the subject matter of the broadened claims in the reissue application can be sworn behind, and the more specific subject matter of the reexamination claims cannot be sworn behind. Criterion (b) can occur if the claims in the reissue application are broader than all claims of the patent as it existed during reexamination (e.g., claims directed to a distinct invention).

(4) What happened in the concluded reexamination proceeding must be taken into account by the examiner as to any new claims presented by the reissue application. This is in addition to any other issue that may be addressed in any reissue application.

(5) If all of the patent claims were canceled by the reexamination certificate, action on the reissue application can still proceed, as will be discussed below; however, patent owner/applicant must first file a petition under 37 CFR 1.183 to waive 37 CFR 1.570 and/or 37 CFR 1.997(d), depending on whether the certificate was issued for an *ex parte* reexamination proceeding, an *inter partes* reexamination proceeding, or a merger of the two. The petition would be grantable where the patent owner/applicant shows that either:(a) The reissue claims are narrower than those claims canceled *>as a result of< the reexamination certificate; or

(b) Criteria (a) and (b) of part (3) above are satisfied by the claims of the reissue application.

The claims satisfying this requirement may only be provided where a petition accompanies the amendment providing the claims

(C) The reissue application can still proceed even where all of the patent claims were canceled by the reexamination certificate, based on the following. Where the reexamination certificate issues and publishes to cancel all existing patent claims, the reissue application can continue in the Office to correct the 35 U.S.C. 251 "error" of presenting the existing claims, which were in-fact unpatentable. Of course, what happened in the concluded reexamination proceeding must be taken into account by the examiner, as to any new claims presented by the reissue application. See the discussion in part (B)(3)(b) above. If a reissue application is filed after a reexamination certificate issues and publishes to cancel all existing patent claims, then the matter should be forwarded to OPLA for resolution.

II. CONCURRENT INTERFERENCE PROCEEDINGS

If the original patent is involved in an interference, the examiner must consult the administrative patent judge in charge of the interference before taking any action on the reissue application. It is particularly important that the reissue application not be granted without the